

REMARKS

The Office Action dated July 10, 2003, has been received and reviewed.

Claims 1 through 20 are currently pending in the above-referenced application.

Claim 10 has been withdrawn from consideration as being directed to a non-elected species of invention.

Each of claims 1 through 9 and 11 through 20 has been considered and currently stands rejected.

Reconsideration of the above-referenced application is respectfully requested.

Objection to the Title

The Office has objected to the title for not accurately reflecting the subject matter recited in the pending claims. The title has been amended to more accurately indicate the subject matter to which the pending claims are drawn. Accordingly, it is respectfully requested that the objection to the title be withdrawn.

Objection to the Abstract

The Abstract, which has been amended, complies with all of the requirements and recommendations that are set forth in the outstanding Office Action. Accordingly, withdrawal of the objection to the abstract is respectfully requested.

35 U.S.C. § 101 Double Patenting Rejection

Claims 1 through 20 are provisionally rejected under 35 U.S.C. § 101 for claiming the same invention as that recited in claims 1 through 20 of copending Application Serial No. 10/035,738 (hereinafter “the ‘738 Application”).

35 U.S.C. § 101 provides in relevant part: “Whoever invents or discovers any new and useful process . . . may obtain a patent therefor . . .” (emphasis added). In explaining the basis on which a double patenting rejection under 35 U.S.C. § 101 should be premised, M.P.E.P. § 804(II)(A) provides:

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. ‘Same invention’ means identical subject matter.

Independent claim 1 of the ‘738 Application recites, among other things, “magnetically drawing [a] first member toward [a] contact,” whereas independent claim 1 of the above-referenced application omits the “magnetically” requirement. As there are a variety of ways other than magnetism that a first member could be drawn toward a contact, it is respectfully submitted that independent claim 1 of the above-referenced application is broader and, thus, differs in scope from, independent claim 1 of the ‘738 Application.

Therefore, it is respectfully submitted that, under 35 U.S.C. § 101, independent claim 1 of the above-referenced application does not recite substantially the same subject matter as that to which independent claim 1 of the ‘738 Application is drawn.

Claims 2 through 7 are each allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

Independent claim 8 of the above-referenced application likewise recites “drawing” instead of the “magnetically drawing” of independent claim 8 of the ‘738 Application. Therefore, for the same reason provided above with respect to independent claim 1, independent claim 8 of the above-referenced application is allowable under 35 U.S.C. § 101 over independent claim 8 of the ‘738 Application.

Each of claims 9 through 20 is allowable, among other reasons, for depending either directly or indirectly from claim 8, which is allowable.

For these reasons, it is respectfully requested that the 35 U.S.C. § 101 rejections of claims 1 through 20 be withdrawn.

Rejections Under 35 U.S.C. § 102(b)

Claims 1 through 7 stand rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by that described in U.S. Patent 3,612,955 to Butherus et al. (hereinafter “Butherus”).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Butherus describes a circuit board that includes magnetized traces and a packaged semiconductor device that includes leads that are either magnetized or formed from a material which is attracted to the source of a magnetic field. Col. 2, lines 59-75. The traces and leads are magnetized in such a way that, with rough alignment of the packaged semiconductor device over the circuit board, the magnetized leads will automatically align with their corresponding, complementarily magnetized traces. Col. 4, line 69, to col. 5, line 7.

Once the leads of the semiconductor device package are aligned with corresponding traces or terminals on the circuit board, the leads may be secured and electrically connected to their corresponding traces or terminals by known processes, such as by thermocompression bonding. Col. 2, lines 47-59.

Independent claim 1 is drawn to a method for establishing an electrical contact with at least one semiconductor device. Electrical contact is established in accordance with independent claim 1 by drawing at least one of a first member and a contact toward the other of the first member and the contact.

While Butherus describes that leads of a packaged semiconductor device may be magnetically attracted to corresponding traces or terminals of a circuit board, Butherus lacks any express or inherent description that the magnetic attraction of the leads to the terminals is sufficient to electrically connect the leads to the traces or terminals. To the contrary, Butherus describes that additional securing of leads to traces or terminals, such as by thermocompression, is necessary. Col. 2, lines 47-59.

It is, therefore, respectfully submitted that Butherus does not and cannot anticipate each and every element of independent claim 1, as is required to maintain a rejection under 35 U.S.C. § 102(b). Accordingly, it is respectfully submitted that, under 35 U.S.C. § 102(b), independent claim 1 is allowable.

Claims 2 through 7 are each allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

Claim 4 is further allowable since each of the electrical connectors of Butherus, which are presumed to be the leads of the packaged semiconductor device, comprises only a single element. Thus, Butherus includes no express or inherent identical description of the element of the claimed invention calling for “positioning a second member of [an] electrical connector opposite [a] first member” of the electrical connector.

Claim 5 depends directly from claim 4 and is also allowable because Butherus neither expressly nor inherently identically describes that oppositely positioned first and second members of an electrical connector may be magnetically attracted to one another. Instead, the description of Butherus is limited to magnetically attracting a single-element lead directly to a trace or terminal.

Claim 6, which also depends directly from claim 4, is additionally allowable because Butherus does not expressly or inherently identically describe securing both first and second members of an electrical connector to a substrate by magnetically attracting at least the first member of the electrical connector to a contact carried by the substrate. Rather, Butherus merely describes attracting single-element leads to corresponding magnetic traces or terminals.

For these reasons, it is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 1 through 7 be withdrawn and that each of these claims be allowed.

Rejections Under 35 U.S.C. § 103(a)

Claims 8, 9, and 11 through 20 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over the subject matter taught in Butherus, in view of the official notice that the Office has taken.

M.P.E.P. § 706.02(j) sets forth the standard for a rejection under 35 U.S.C. § 103(a):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The teachings or suggestions of Butherus are summarized above.

The Office has taken official notice of two teachings. First, the Office has taken official notice that "it is well known in the art to provide ground and power to electronic components to energize them." Office Action dated July 25, 2003, page 4. Second, the Office has taken official notice that, "during burn-in testing[,] [sic] heat is provide[d] [sic] either cyclically or variously to purposely fail the [burned-in] component." *Id.*

It is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against any of claims 8, 9, or 11 through 20 since Butherus and the subject matter for which official notice has been taken do not teach or suggest each and every claim limitation set forth in any of claims 8, 9, or 11 through 20.

Independent claim 8 recites a method for stress testing a plurality of semiconductor devices that are carried upon a common substrate and that are in communication with common ground and power contacts. The method of independent claim 8 includes establishing electrical contact between a first member of an electrical connector and at least one common contact, with at least one of the first member and the at least one common contact being drawn toward the other.

It is respectfully submitted that Butherus lacks any teaching or suggest that one of a first member of an electrical connector and a contact may be drawn to the other to establish an electrical connection therebetween. Rather, the teaching of Butherus are limited to generating a sufficient magnetic field to properly align leads of a packaged semiconductor device with corresponding traces or terminals of a circuit board. *See, e.g.*, Col. 4, line 69, to col. 5, line 7.

Moreover, Butherus does not teach or suggest that electrical contact may be established between a first member of an electrical connector and a contact, such as a power contact or a ground contact, which is *common to* a plurality of semiconductor devices. Nor has the Office cited any art which teaches or suggests that electrical contact may be established between a first member of an electrical connector and a contact which is common to a plurality of semiconductor devices during stress testing.

Further, the mere fact that electrical connections are made during stress testing does not inherently lead to the conclusion that magnetic attraction of the type taught in Butherus would be adequate for establishing electrical connections that will withstand stress testing conditions, nor would one of ordinary skill in the art have any reason to expect that the type of magnetic attraction taught in Butherus could be successfully used for such a purpose.

For these reasons, it is respectfully submitted that the Office has not established a *prima facie* case of obviousness against independent claim 8 under 35 U.S.C. § 103(a). Accordingly, it is respectfully submitted that, under 35 U.S.C. § 103(a), independent claim 8 is allowable over both the teachings of Butherus and the teachings for which the Office has taken official notice.

Each of claims 9 and 11 through 20 is allowable, among other reasons, for depending either directly or indirectly from claim 8, which is allowable.

Claim 11 is further allowable since each of the electrical connectors of Butherus, which are presumed to be the leads of the packaged semiconductor device, comprises only a single element. Thus, Butherus includes no teaching or suggestion of “positioning a second member of [an] electrical connector opposite [a] first member” of the electrical connector.

Claim 12 depends directly from claim 11 and is also allowable because Butherus neither teaches nor suggests that oppositely positioned first and second members of an electrical connector may be drawn to one another. Instead, the teachings or suggestions of Butherus are limited to attracting a single-element lead directly to a trace or terminal.

Claim 13, which depends directly from claim 12, is additionally allowable because Butherus includes no teaching or suggest that first and second members of an electrical connector may be magnetically attracted to one another.

Claim 15 is further allowable since Butherus does not teach or suggest *securing* a first member of an electrical connector to a contact. Rather, Butherus merely teaches or suggests attracting single-element leads to corresponding magnetic traces or terminals. Securing of the leads to the traces or terminals is then effected by conventional bonding techniques, such as thermocompression. Col. 2, lines 47-59.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 8, 9, and 11 through 10 be withdrawn.

Election of Species Requirement

As claim 8 is allowable, it is respectfully requested that claim 10 also be considered and allowed.

CONCLUSION

It is respectfully submitted that each of claims 1 through 20 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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